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EXAMINER

CHEVALIER, ALICIA ANN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRED A. ANTONINI

Appeal 2009-014173
Application 10/523,942
Technology Center 1700

Before EDWARD C. KIMLIN, CHUNG K. PAK, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL¹

I. STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's
decision to reject claims 1, 2, 4-25, and 36-40 under 35 U.S.C. § 103(a) as

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

unpatentable over Kobe (US 6,372,323 B1; Apr. 16, 2002) in view of Braun (US 5,300,171; Apr. 5, 1994), and as evidenced by Tokas (US 6,960,272 B1; Nov. 1, 2005)². We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellant's invention relates to a thin film having a silicone elastomer coating for use as an anti-slip skin, grip, or appliqué that can be applied to various items (Spec. 2:21-25). Claims 1, 6, 11, 12, 13, 16 and 25 are illustrative:

1. A film comprising:
 - a dimensionally stable, thin plastic film having a smooth surface finish; and
 - a thin layer of silicone elastomer having a durometer of less than 30 on the Shore A scale disposed on a first surface of the plastic film.³
6. The film according to claim 1, wherein the silicone elastomer has a polished surface finish.
11. The film according to claim 10, wherein the texture is an array of upraised dimples.

² The Examiner also maintains the provisional rejections of claims 1-25 under the doctrine of obviousness-type double patenting over claims 1-6 of Application No. 11/072,382 and claims 1-25 of Application No. 10/524,367 in view of Braun. Appellant does not traverse the merits of the double patenting rejections (*see generally* Br.; Reply Br. 4). As Appellant has waived any arguments against the rejections, we summarily affirm the provisional obviousness-type double patenting rejections.

³ It is undisputed that claim 1 was stated incorrectly in Appellant's Appeal Brief (Ans. 3; Reply Br. 2). This recitation represents the correct wording for claim 1.

12. The film according to claim 1, wherein the silicone elastomer has a matte surface finish.

13. The film according to claim 1, wherein the plastic film is a heat stabilized plastic film.

16. The film according to claim 1, further comprising:
graphical indicia associated with the plastic film.

25. The film according to claim 1, further comprising:
a label stock having graphical indicia adhered to the plastic film, such that the graphical indicia is visible.

Appellant presents arguments with respect to claims 1, 2, and 4-5 as a group, for which we select claim 1 as representative, claims 6-10 as a group, for which we select claim 6 as representative, and has presented identical arguments for claims 13 and claims 36-40, for which we select claim 13 as representative. Appellant also presents separate arguments for claims 11, 12, 16, and 25. Accordingly, we select claims 1, 6, 11, 12, 13, 16, and 25 to decide the issues on appeal.

We adopt the Examiner's findings in the Answer as our own and add any additional findings of fact appearing below for emphasis.

II. CLAIM 1

A. ISSUE ON APPEAL

A first issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant's view that the Examiner erred in concluding that the claimed durometer range would have been obvious to one of ordinary skill in the art based on the teachings of Kobe and Braun? We answer this question in the negative.

B. DISCUSSION

The Examiner contends that “in view of Kobe’s range of Shore A scale range [sic] which encompass Appellant’s claimed narrower range and the disclosure of Braun showing that lower Shore A values are more flexible, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article” (Ans. 12). We fully agree that the Examiner’s reasoning has established a prima facie case of obviousness.

The Examiner has provided sufficient evidence that a durometer range is known in the prior art that encompasses the claimed range of less than 30 on the Shore A scale (Ans. 12). Specifically, Kobe teaches a most preferred Shore hardness range of “less than 60A” (Kobe, col. 7, ll. 63-66). The Examiner has also shown that it was known in the art to choose a particular durometer to achieve a desired flexibility and/or hardness based on the teachings of Kobe and Braun. Moreover, Braun clearly teaches using an elastomer with a Shore A durometer as low as 30A (Braun, col. 4, ll. 66-68). One of ordinary skill in the art also would have expected similar properties to be present at least at durometer measurements of somewhat less than 30A.

An improvement in the art is obvious if “it is likely the product not of innovation but of ordinary skill and common sense.” *KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Optimization of a variable which is recognized in the prior art to be a result effective variable would ordinarily be within the skill in the art. *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980); *see also In re Aller*, 220 F.2d 454, 456 (CCPA 1955) (“[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”).

It is true that a routine variable change sometimes causes an unexpected effect. In such a situation, the claimed subject matter will be unobvious under the law if Appellant presents a showing of criticality of the range for unexpected beneficial results. *See Boesch*, 617 F.2d at 276 (CCPA 1980); *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990). Appellant has provided no evidence of superior or unexpected properties that occur in the elastomer beginning at a durometer of less than 30A, other than the expected changes in flexibility that would have been apparent to the ordinary artisan.

Appellant provides Declaration evidence to support the position that the proposed combination would not have been obvious because (a) the claimed durometer range of less than 30 on the Shore A scale provides critical frictional properties to the claimed film, (b) silicone elastomers having the claimed durometer exhibit shear strengths that are lower than desirable for Kobe's article, and (c) a person would have avoided using silicone elastomers with the claimed durometer, as such elastomers are difficult to bond to other materials (Br. 12).

We agree with the Examiner that Appellant's Declaration is of limited probative value. The Declaration provides no factual evidence, such as data relevant to the distinctions between durometers of less than 30 and durometers of 30 or greater, to support Appellant's statements of unexpected results. Moreover, Appellant's statements about the functioning of Kobe's invention appear to contradict the express teachings of Kobe that a range of "less than 60A" would be functionally operative. Without further probative evidence to support Appellant's position, we are not persuaded to disregard the evidence of the prior art based on Appellant's conflicting statements.

III. CLAIMS 6 AND 12

Although argued separately by Appellant, the issue raised with respect to claims 6 and 12 are substantially similar.

A. ISSUE ON APPEAL

A second issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant's view that the Examiner erred in concluding that a polished surface finish and/or a matte surface finish would have been obvious to one of ordinary skill in the art based on the teachings of Kobe? We answer this question in the negative.

B. DISCUSSION

Appellant contends that Kobe fails to teach a polished or matte surface finish on a microscopic scale, as the term "surface finish" is defined in the Specification (Br. 15 and 17).

The Examiner contends that Appellant's Specification does not describe a surface topography for a "polished" or "matte" surface finish that would distinguish the claimed surface from the non-raised/flat surface taught by Kobe. We agree with the Examiner that the terms "polished" and "matte" are not defined by a degree of smoothness or roughness which distinguishes the claimed structure over the prior art structures.

During examination, "claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (*quoting In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)).

Although Appellant's Specification describes a surface finish in terms of a microscopic scale (Spec. 5:2-3), we find no description in Appellant's Specification of the microscopic elements that distinguish between a textured/matte or polished surface finish. We decline to read into the terms "polished" and "matte" a particular degree of smoothness or roughness. Absent claim language carrying a narrow meaning, we only limit the claim based on the specification when those sources expressly disclaim the broader meaning. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Appellant's Specification also states that both "the textured and polished surface finish of silicone-elastomer film 11 is preferably formed by a casting means" or "by other means, such as tools, dies, or rollers" (Spec. 5: 26-31). Kobe likewise describes forming the elastomer by extruding one or more layers of a thermoplastic material into a mold 156, such as a roll 158, which has on its outer cylindrical surface a desired surface pattern that is transferred to the molten material as it passes over the cylindrical surface of the roll (Kobe, col. 9, l. 66 to col. 10, l. 6). Appellant has fails to show a clear distinction between the claimed surface finish and that which is taught by the prior art.

IV. CLAIM 11

A. ISSUE ON APPEAL

A third issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant's view that the Examiner erred in concluding that an array of upraised dimples would have been obvious to one of ordinary skill in the art based on the teachings of Kobe? We answer this question in the negative.

B. DISCUSSION

The Examiner finds that Kobe discloses a textured surface that includes an array of upraised dimples (Ans. 8). Appellant states that a “dimple” is an “indented, hollowed or depressed area in the surface of something” and that Kobe fails to teach “upraised dimples” (Br. 17). The Examiner responds that Appellant’s definition is not supported by the Specification (Ans. 15).

We agree with the Examiner that Appellant’s definition is not supported by the Specification. According to Appellant’s proposed definition, the claimed surface would have indented, hollowed, or depressed areas. Yet, Appellant’s Specification describes only one dimpled structure with respect to the “enlarged view” of Figure 3 showing “upraised bubble-shaped dimples 21 being separated by narrow-valleys 23” (Spec. 5:23-25; Figure 2). Figure 2 shows a field labeled as the valleys 23 and circles in that field labeled as the dimples 21. The description of the “dimples” as “bubble-shaped” and “upraised” and the structure shown in Figure 2 convey that the “dimples” are convex, rather than concave or indented, structures. Accordingly, Appellant’s own Specification suggests a meaning different than the one proposed by Appellant. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) (“the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO’s definition unreasonable when the PTO can point to other sources that support its interpretation.”).

Since the claimed “upraised dimples” may be upraised convex surfaces, the claims read on, and are not distinguishable from, the raised stems taught by Kobe, particularly since Kobe further teaches that those

stems can have a variety of non-cylindrical shapes including “hemispheres,” i.e., bubble-shapes (Kobe, col. 5, ll. 13-15).

V. CLAIM 13

A. ISSUE ON APPEAL

A fourth issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant’s view that the Examiner erred in concluding that a heat stabilized film would have been obvious to one of ordinary skill in the art based on the teachings of Kobe? We answer this question in the negative.

B. DISCUSSION

The Examiner contends that the term “heat stabilized” is a method limitation, and that there is no evidence that the claimed product differs in kind from the dimensionally stable plastic film taught by Kobe (Ans. 8 and 15).

Appellant contends that “heat stabilized” would be understood by one of ordinary skill in the art as a structural limitation meaning “a film that is substantially dimensionally stable when subjected to heat” and that the references fail to disclose a heat stabilized film (Br. 18-19; Decl. ¶ 11).

The Specification states that “it is preferred that plastic film 73 be heat stabilized prior to use” indicating that heat stabilization is a process (Spec. 8). The Specification further states that “[t]his heat stabilization ensures that plastic film 73 can endure the heat cycle of the curing process without cockling or buckling.” (Spec. 8.) Again, the Specification uses “heat stabilization” to refer to a process for preventing cockling or buckling.

We agree with the Examiner that claim 13 recites a product-by-process limitation and that the property that the film must possess is

dimensional stability, irrespective of the particular method used to impart the stability, such as the addition of heat. “[I]t is the patentability of the *product* claimed and *not* of the recited process steps which must be established.”

In re Brown, 459 F.2d 531, 535 (CCPA 1972).

Kobe teaches that the backing layer may be substantially inelastic “to prevent necking or stretching of the slip control device” (Kobe, col. 5, ll. 48-50). Accordingly, claim 13 reads on the dimensionally stable film taught by Kobe. Appellant has provided no evidence of a different structure based on the fact that the film was stabilized by a particular process.

Moreover, neither claim 13 nor Appellant’s Specification recites a degree of heat necessary or a degree of dimensional stability acquired by heating the film. Accordingly, claim 13 may be interpreted as requiring only the most minor degree of stability added by the most minor degree of heat. One of ordinary skill in the art would be unable to distinguish a “heat stabilized” film from any other dimensionally stable film as claimed.

VI. CLAIMS 16 AND 25

Although argued separately by Appellant, the issue raised with respect to claims 16 and 25 are substantially similar.

A. ISSUE ON APPEAL

A fifth issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant’s view that the Examiner erred in concluding that graphical indicia, provided either on the claimed film or as a separate label stock, would have been obvious to one of ordinary skill in the art based on the teachings of Kobe? We answer this question in the negative.

B. DISCUSSION

Appellant contends that one of ordinary skill in the art would appreciate that the pigments/dyes taught by Kobe are merely batch additives and do not create a graphical indicia, as recited in claim 16 (Ans. 19), and that the cited references fail to disclose or suggest a label stock having graphical indicia, as required by claim 25 (Ans. 20).

The Examiner notes that “when the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art” (Ans. 16). *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.”).

The mere inclusion of a form of identification, such as a logo or other identifying graphical indicia, either by printing on the item or by attaching a label, is a well known practice in almost every commercial art. We find the inclusion of graphical indicia in any form to be an obvious modification to any article of manufacture, including the slip control article taught by Kobe. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). An obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418.

Appellant has pointed to no unobvious properties or advantages gained by such a well known inclusion.

VII. CONCLUSION

On the record before us and for the reasons discussed above, we sustain the rejection maintained by the Examiner.

VIII. DECISION

We affirm the Examiner's decision.

IX. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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